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UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF OHIO
EASTERN DIVISION

AARON CLARK, Plaintiff, v. **THE WALT DISNEY COMPANY; JAKKS PACIFIC, INC.; PLAY ALONG TOYS; KB TOYS; TOYS 'R US; BABYUNIVERSE, INC.; ETOYS DIRECT, INC.; and DISNEY SHOPPING, INC.,** Defendants.	Case No. 2:08CV982

MOTION TO STRIKE DECLARATION OF ELLEN M. SHAPIRO

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MOTION TO STRIKE

Defendants respectfully move to strike the Declaration of Ellen M. Shapiro ("Shapiro Declaration") filed by Plaintiffs in Opposition to Defendants Motion for Summary Judgment. This Motion is made pursuant to Federal Rules of Civil Procedure 402, and 702, on the grounds that the Shapiro Declaration is not relevant, and is not sufficiently reliable to be admissible.

Dated: August 24, 2009

Respectfully submitted,

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MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF MOTION TO STRIKE

I. THE COURT SHOULD STRIKE SHAPIRO'S OPINION REGARDING THE PROPER CONSTRUCTION OF THE "HOUSING" LIMITATION

A. Conclusory Opinions Are not Admissible

Plaintiffs offer the Shapiro Declaration in opposition to Defendants Motion for Summary Judgment as supposed evidence of how one of ordinary skill in the art would construe the "housing" claim limitation. According to the Shapiro Declaration, one of ordinary skill in the art would construe the "housing" claim limitation as "the color, finish, and surface artwork of the housing form a harmonious visual effect with the art of the poster." Shapiro allegedly bases her conclusion on the "intrinsic record, dictionaries," the color wheel and the Pantone Matching System. The Shapiro Declaration is inadmissible.

The Federal Circuit describes the standards for admissible expert testimony in the context of claim construction. In *Phillips,* the court stated,

> … ***conclusory, unsupported assertions*** by experts as to the definition of a claim term are ***not useful*** to a court. Similarly, a court should ***discount*** any expert testimony that is ***clearly at odds*** with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent.

Phillips v. AWH Corp., 415 F.3d 1303, 1318 (Fed. Cir. 2005) (emphasis added).

Further, Federal Rule of Evidence 702 only permits introduction of supposed expert testimony that "will assist the trier of fact to understand the evidence or to determine a fact in issue." FED. R. EV. 702. Thus, supposed expert testimony that is, as a matter of law, not useful is also inadmissible.

B. The Shapiro Declaration Is Conclusory, not Useful, and, Therefore, Inadmissible

The fulcrum of the Shapiro Declaration is her opinion regarding the proper claim construction of the "housing" limitation. As to this supposed opinion, the Shapiro Declaration is conclusory and based exclusively on unsupported assertions. Shapiro claims that her opinion on claim construction is based on (1) intrinsic evidence, (2) dictionary definitions, and (3) "comparable sources."

Shapiro does not identify even a single reference from the intrinsic record upon which her opinion is supposedly based. That is, she does not cite to the claims, the specification, or the prosecution history to support her opinion. She does not cite the intrinsic record because no support for her opinion exists anywhere in the intrinsic record. Similarly, although Shapiro refers to dictionary definitions, she does not attaché any definitions to her declaration.

Shapiro's opinion relies exclusively on the color wheel and the Pantone Matching System to define the phrase "artistically blends." Shapiro claims that the color wheel and the Pantone Matching System are "comparable sources" on which experts would rely as discussed in *Phillips*. *See, Phillips*, 415 F.3d 1318. Shapiro is wrong for a number of reasons.

First, and most importantly, the "artistically blends" limitation is only part of the entire claim limitation and is not even the portion of the "housing" limitation at issue in this motion. Instead, the relevant portion of the "housing" limitation is the portion that requires that the housing surface be prepared with "matching art" that is "substantially the same" as the art that the housing covers. As to this critical limitation, the Shapiro Declaration is silent. Second, Shapiro offers no explanation or evidence as to how or why the "comparable sources" of the color wheel or Pantone Matching System are relevant. She offers no evidence from the intrinsic record demonstrating that a supposed expert would rely on any of these items. Instead, Shapiro's opinion regarding the use of the color wheel and the Pantone Matching System is nothing more than an utterly unsupported—and unsupportable—*ipse dixit.*

C. The Shapiro Declaration is Contrary to the Intrinsic Evidence

As demonstrated in detail in Defendants' Supplemental Brief, the intrinsic evidence, including the language of the claims, the specification, and the prosecution history, support only one interpretation; namely, that no special construction is required at all, and that the common, ordinary meaning of the terms controls. Shapiro's reliance on the color wheel and the Pantone Matching System, by contrast, attempts to read the critical "covers" limitations out of the claims and ignores the plain and unambiguous claim language. Shapiro's opinion is, therefore, "clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent." *Phillips*, 415 F.3d at 1318. As such, Shapiro's opinion regarding proper construction of the "housing" limitation is inadmissible, and should be stricken.

II. SHAPIRO'S OPINION REGARDING THE RELEVANT ART IS INADMISSIBLE

For a witness to qualify as an expert under Federal Rule of Evidence 702, she must establish expertise based on her knowledge, skill, experience, training, or education *in the relevant field*. FED. R. EVID. 702. A witness who may be qualified as an expert in one particular field may not be qualified as an expert in another, even if related, field. *See Amorgianos v. Nat'l R.R. Passenger Corp.*, 303 F.3d 256, 270 (2nd Cir. 2002) (holding industrial hygienist not qualified to testify on general medical causation); *Cummins v. Lyle Indus.*, 93 F.3d 362, 366-68 (7th Cir. 1996); *Daubert II*, 43 F.3d at 1317-18, 1318 n.9 (excluding plaintiff's experts who had expertise in their respective fields, but not in the specific issue in the case) (affirming summary judgment for defendants where testimony of plaintiff's experts were excluded).

Moreover, the burden to demonstrate that an opinion is reliable lies squarely on the shoulders of the proponent of the testimony. *Southland Sod Farms v. Stover Seed Co.*, 108 F.3d 1134, 1141 (9th Cir. 1997).

There is no evidence that Shapiro is an expert *in the relevant field.* Shapiro is a graphic designer and writer. But she apparently has no background in engineering or electronics whatsoever. While she claims to be a person of ordinary skill in the art, she fails to identify what the particular art is, or how she qualifies as an expert therein. Put differently, there is no evidence whatsoever that graphic design is the appropriate art to render an opinion in this case. Thus, because it was Plaintiffs' burden to establish the admissibility of Shapiro's opinion, and because Plaintiffs failed to do so, Shapiro's opinion must be rejected.

III. CONCLUSION

For all of the reasons stated above, the Shapiro Declaration should be stricken in its entirety.

Dated: August 24, 2009

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the counsel of record who are deemed to have consented to electronic service are being served today with a copy of this document via the Court's CM/ECF system per Local Rule 5.2. Any other counsel of record will be served by electronic mail, facsimile transmission and/or first class mail on this same date.

Dated: August 24, 2009 /s/ Grant E. Kinsel

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